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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/333,565 | 06/21/1999 | NICHOLAS STEIGELMAN | 034297-031 | 4249 |

7590

09/30/2004

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/333,565 | Applicant(s) STEIGELMAN ET AL. | |
| | Examiner Jefferey F Harold | Art Unit 2644 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1, 3 and 12-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Aldous et al. (United States Patent 5,183,404), hereinafter referenced as Aldous.

Regarding **claim 1**, Aldous discloses systems for connection of physical/electrical media connectors to computer communication cards. In addition, Aldous discloses a modem (10), which reads on claimed “shell” adapted to physically connect under a telephone, the modem having a port (18) to connect to the telephone wire (20); the modem containing DAA circuit operably connected to the telephone (POTS) port and the computer connection port and a wire to connect to the telephone; and an inherent printed circuit board, which reads on claimed “networking card”, in the modem for connecting to the personal computer, the printed circuit board being operably connected to the DAA circuitry, wherein digital data from the printed circuit board and voice data from the telephone can be alternately sent across the telephone wire, as disclosed at column 4, line 37 through column 5, line 8 and exhibited in figure 1.

Regarding **claim 3**, Aldous discloses everything claimed as applied above (see claim 1), in addition Aldous discloses wherein the modem has a port to connect to the

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personal computer, as disclosed at column 4, line 37 through column 5, line 8 and exhibited in figure 1.

Regarding **claims 12-15**, Aldous discloses everything claimed as applied above. In addition claims 12-15 are interpreted and thus rejected for the reasons set forth above in the rejection of claims 1 and 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 2 and 4-6*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldous in view of well know prior art (MPEP 2144.03).

Regarding **claim 2**, Aldous disclose everything claimed, as applied above, (see claim 1), however, Aldous fails to disclose wherein the modem is wedge shaped. However, the examiner takes official notice of the fact that it was well know in the art to provide a wedge shaped modem.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aldous by specifically providing a wedge shaped modem, for the purpose of allowing the modem/telephone connection to be connected to a wall.

Regarding **claim 4**, Aldous disclose everything claimed, as applied above, (see claim 1), however, Aldous fails to disclose wherein the electronics in the modem allow for wireless connection to the personal computer. However, the examiner takes official notice of the fact that it was well know in the art to provide wherein the electronics in the modem allow for wireless connection to the personal computer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aldous by specifically providing the electronics in the modem allow for wireless connection to the personal computer, for the purpose of allowing unencumbered access to the modem circuitry for connection to the internet.

Regarding **claim 5**, Aldous disclose everything claimed, as applied above, (see claim 1), however, Aldous fails to disclose wherein the modem has extensions for physically connecting to the bottom of the telephone. However, the examiner takes official notice of the fact that it was well know in the art to provide wherein the modem has extensions for physically connecting to the bottom of the telephone.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aldous by specifically providing wherein the modem has extensions for physically connecting to the bottom of the telephone, for the purpose maintaining stable connection between the telephone and modem.

Regarding **claim 6**, Aldous disclose everything claimed, as applied above, (see claim 1), however, Aldous fails to disclose wherein the printed circuit board is an Ethernet card. However, the examiner takes official notice of the fact that it was well know in the art to provide wherein the printed circuit board is an Ethernet card.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aldous by specifically providing wherein the printed circuit board is an Ethernet card, for the purpose of allowing the computer to connect to a local area network.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F Harold whose telephone number is 703-306-5836. The examiner can normally be reached on Monday - Friday 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JFH

September 21, 2004

Jefferey F Harold
Examiner
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